



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,431	08/29/2001	Taisei Matsumoto	NIT-297	7065

7590 06/06/2005  
MATTINGLY, STANGER & MALUR  
Suite 370  
1800 Diagonal Road  
Alexandria, VA 22301

EXAMINER

REILLY, SEAN M

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/940,431

Applicant(s)

MATSUMOTO, TAISEI

Examiner

Sean Reilly

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office action is in response to Applicant's amendment and request for reconsideration filed on 2/14/05. Claims 1-21 have been canceled. Claims 22-42 are presented for further examination.

### ***Priority***

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
2. Regarding claims 40-42, Applicant claims multiple "units", which are software per se. A software program which is not tangibly embodied on a computer readable medium, is merely a manipulation of abstract ideas.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22-25, 32-35, and 40-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically the specification failed to disclose posting the presence of an unopened electronic mail *when a notification is not received from an electronic mail destination terminal* within a predetermined time. The specification merely provides support for a mail management server monitoring the state of e-mails held on the server.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 24, 32, 34, and 42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Regarding claims 24 and 42, as written the claims are indefinite. The correlation between the time zone and when posting can occur is not clear. It is presumed that the time zone defines

Art Unit: 2153

a period of time when the posting of unopened electronic mail messages may not be performed.

Additionally is not clear which communication terminal is being referenced.

6. Claim 32 recites the limitation "the unopened notification condition master." There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 22 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Toshiaki (Japan Patent Publication 11-338797).

8. The specification references cited below reference the JPO computer translation mailed to Applicant in the previous office action.

9. Regarding claims 22 and 40, Toshiaki disclosed an electronic mail management method comprising the steps of:

- receiving an electronic mail sent from an electronic mail sending source terminal to an electronic mail destination terminal through a first communication means (¶ 4);
- storing said electronic mail received (e.g. storage in mailbox MBX, ¶ 5); and
- posting a presence of an unopened electronic mail (transmission to urgent destination) to a communication terminal that is different from said electronic mail sending source

terminal (urgent destination) through a second communication means which is different from said first communication means, when an open notification of said stored mail is not received from said electronic mail destination terminal within a predetermined time (unopened time limit) (see inter alia, ¶s 4 and 7).

10. Claims 26 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenichi et al. (Japan Patent Publication 2000-270006; hereinafter Kenichi).

11. Regarding claim 26, Kenichi disclosed an electronic mail management method, comprising the steps of:

- setting a combination of a sending source mail address, a receiving mail address, and an unopened time limit (expiration date) in an unopened notification condition master (term managed table) (¶ 09); and
- posting to a sender of electronic mail by a preset means that the electronic mail sent is unopened when the electronic mail sent from the sending source mail address set in the unopened notification condition master to the receiving mail address is unopened for a period of time exceeding the unopened time limit (¶ 26);
- wherein an electronic mail sending source can refer to information of the unopened time limit that is set to be posted to the sending source by specifying the sending source mail address set in the unopened notification condition master (¶ 09).

12. Regarding claim 27, Kenichi disclosed contents of modifications are validated under approval of the corresponding sending source when a record set in the unopened notification condition master is added, modified or deleted (e.g. expiration dates set by the sender side ¶ 09).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 23, 25, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Toshiaki (Japan Patent Application Publication 11-338797) and Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi).

14. Regarding claims 23 and 41, Toshiaki failed to specifically recite posting the presence of said unopened electronic mail to said electronic mail sending source terminal if, after the posting of the presence of said unopened electronic mail to said communication terminal through said second communication. Nevertheless alerting the sender of an e-mail that the e-mail hasn't been read after a given period of time was well known in the art at the time of the invention, as evidenced by Kenichi. In an analogous art Kenichi disclosed an email system where the sender of an email is alerted to the presence of an unopened email after a period of time (see ¶ 11). It would have been advantageous to a person having ordinary skill in the art at the time of the invention to incorporate the sender unopened notification system disclosed by Kenichi within Toshiaki's system, since Kenichi disclosed alerting the sender of unopened email relieves the sender from the burden of contacting the recipient via other means when the sender has already opened the email, thus harnessing the advantage of e-mail (¶ 05).

15. Regarding claim 25, Kenichi disclosed the contents of the posting are made to differ according to whether the destination of the posting of the unopened electronic mail is the communication terminal or the electronic mail sending source terminal (notifications to the sending source include “notice information,” ¶ 12 and 26).

16. Claims 24 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki (Japan Patent Application Publication 11-338797) and Takahashi et al. (U.S. Patent Number 6,442,589; hereinafter Takahashi).

17. Regarding claims 24 and 42, Toshiaki fails to specifically recite a time zone is predetermined where the posting of the presence of the unopened electronic mail to said communication terminal cannot be performed. In an analogous art, Takahashi disclosed an electronic posting system (abstract) where electronic messages are posted during a certain predetermined time zone (time period) (Takahashi Col 6, lines 41-43). It would have been advantageous to a person having ordinary skill in the art at the time of the invention to incorporate the teachings of Takahashi within the system disclosed by Toshiaki, so users are only notified of electronic messages during desired periods of time (e.g. during normal business hours).

18. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi).



Art Unit: 2153

19. Regarding claim 28, Kenichi fails to specifically recite the effect of the modifications is automatically posted to the corresponding sending source when the record set in the unopened notification condition master is added, modified or deleted. Nevertheless it was well known at the time of the invention to automatically send a user a receipt containing changes to a record. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to send the sending source in Kenichi's system a receipt for changes (e.g. the sending source specifying an unopened time limit ¶ 09) to the unopened notification condition master (term managed table), so the sender has a record of the transaction.

20. Claims 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi) and Applicant Admitted Prior Art.

21. Regarding claims 29-31, Kenichi fails to specifically recite charging to the user is performed in accordance with setting items to the unopened notification condition master. Nevertheless as Applicant has admitted it was well known at the time of the invention to charge a fee for services rendered, including notification services. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate within Kenichi's system, charging a user in accordance with setting items to the unopened notification condition master, in order to receive compensation for services provided to a user.

22. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki (Japan Patent Application Publication 11-338797) and Applicant Admitted Prior Art.

Art Unit: 2153

23. Regarding claim 32, Toshiaki fails to specifically recite charging to the user is performed in accordance with setting items to the unopened notification condition master. Nevertheless as Applicant has admitted it was well known at the time of the invention to charge a fee for services rendered, including notification services. Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention to incorporate within Toshiaki's system, charging a user in accordance with setting items to the unopened notification condition master, in order to receive compensation for services provided to a user.

24. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki (Japan Patent Application Publication 11-338797) and Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi) and Botts et al. (U.S. Patent Number 6,122,632; hereinafter Botts).

25. Regarding claims 33 and 35, Toshiaki and Kenichi both fail to specifically recite information on a number of received mail items that is an unopened notification management object for each recipient and a number of received mail items for which the unopened notification is performed to the mail sending source among the received mail items is held and provided as a mail management information of the recipient. Nevertheless mail management information tracking systems were well known in the art at the time of the invention, as evidenced by Botts. In an analogous art, Botts disclosed a mail management system where electronic message status and history characteristics are tracked (Abstract). For instance Botts's system records the status of messages including the read status and the response state (Botts see Figure 14). A log of actions related to each message is also tracked (Botts history reports figure

12 and 14). Botts's system also allows mail management information to be retrieved in various formats (Botts see inter alia figures 30-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Botts's management system within the combined Toshiaki and Kenichi system, in order to provide a means for quality assurance within the email management system (Botts Col 1, lines 51-54 and Col 2, lines 12-27).

26. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toshiaki (Japan Patent Application Publication 11-338797) and Takahashi et al. (U.S. Patent Number 6,442,589; hereinafter Takahashi) and Botts et al. (U.S. Patent Number 6,122,632; hereinafter Botts).

Regarding claim 34, Toshiaki and Takahashi both fail to specifically recite information on a number of received mail items that is an unopened notification management object for each recipient and a number of received mail items for which the unopened notification is performed to the mail sending source among the received mail items is held and provided as a mail management information of the recipient. Nevertheless mail management information tracking systems were well known in the art at the time of the invention, as evidenced by Botts. In an analogous art, Botts disclosed a mail management system where electronic message status and history characteristics are tracked (Abstract). For instance Botts's system records the status of messages including the read status and the response state (Botts see Figure 14). A log of actions related to each message is also tracked (Botts history reports figure 12 and 14). Botts's system also allows mail management information to be retrieved in various formats (Botts see inter alia figures 30-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Botts's management system within the combined Toshiaki and

Takahashi system, in order to provide a means for quality assurance within the email management system (Botts Col 1, lines 51-54 and Col 2, lines 12-27).

27. Claims 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi) and Botts et al. (U.S. Patent Number 6,122,632; hereinafter Botts).

28. Regarding claims 36-38, Kenichi failed to specifically recite information on a number of received mail items that is an unopened notification management object for each recipient and a number of received mail items for which the unopened notification is performed to the mail sending source among the received mail items is held and provided as a mail management information of the recipient. Nevertheless mail management information tracking systems were well known in the art at the time of the invention, as evidenced by Botts. In an analogous art, Botts disclosed a mail management system where electronic message status and history characteristics are tracked (Abstract). For instance Botts's system records the status of messages including the read status and the response state (Botts see Figure 14). A log of actions related to each message is also tracked (Botts history reports figure 12 and 14). Botts's system also allows mail management information to be retrieved in various formats (Botts see inter alia figures 30-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Botts's management system within Kenichi's system, in order to provide a means for quality assurance within the email management system (Botts Col 1, lines 51-54 and Col 2, lines 12-27).

Art Unit: 2153

29. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kenichi et al. (Japan Patent Application Publication 2000-270006; hereinafter Kenichi) and Applicant Admitted Prior Art and Botts et al. (U.S. Patent Number 6,122,632; hereinafter Botts).

30. Regarding claim 39, Kenichi failed to specifically recite information on a number of received mail items that is an unopened notification management object for each recipient and a number of received mail items for which the unopened notification is performed to the mail sending source among the received mail items is held and provided as a mail management information of the recipient. Nevertheless mail management information tracking systems were well known in the art at the time of the invention, as evidenced by Botts. In an analogous art, Botts disclosed a mail management system where electronic message status and history characteristics are tracked (Abstract). For instance Botts's system records the status of messages including the read status and the response state (Botts see Figure 14). A log of actions related to each message is also tracked (Botts history reports figure 12 and 14). Botts's system also allows mail management information to be retrieved in various formats (Botts see inter alia figures 30-34). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Botts's management system within Kenichi's system, in order to provide a means for quality assurance within the email management system (Botts Col 1, lines 51-54 and Col 2, lines 12-27).

### ***Response to Arguments***

31. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

32. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

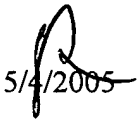
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

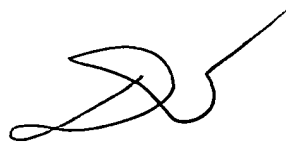
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
5/4/2005



Dung C. Dinh  
Primary Examiner